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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/330,690 06/11/99 MAMEDOV

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EXAMINER

IM22/0605

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WOOD, E

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

06/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/330,690**

Applicant(s)  
**Mamedov et al.**

Examiner  
**Elizabeth D. Wood**

Group Art Unit  
**1755**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) 11-20 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a catalyst composition, classified in class 502, subclass 300+.
- II. Claims 11-20, drawn to an oxidative dehydrogenation process, classified in class 585, subclass 661+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition has claimed has utility for a materially different process such as ammoxidation.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Moreno on February 2, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-20 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### *Specification*

The specification has not been checked to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicants is requested in correcting any errors of which applicants may become aware of in the specification, in the claims and in any future amendment(s) that applicants may file.

Applicants are also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated to facilitate the prosecution of this application.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,219,671 to Slinkard et al.

Slinkard et al. disclose catalyst compositions that are mixed metal oxides containing vanadium, antimony, aluminum and zinc which read on the herein claimed compositions. The difference between the instant claims and the prior art is that the prior art does not identically disclose the amounts of each component present as is herein claimed. However, there is overlap between the catalyst ingredients and it is well settled that overlapping subject matter constitutes a prima facie case of obviousness. See particularly column 2.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,139,988 to Sasaki et al.

Sasaki et al. disclose catalyst compositions that are mixed metal oxides containing iron, antimony, vanadium and at least one of (which includes mixtures) alkali or alkaline earth metals and aluminum which read on the herein claimed compositions. The difference between the instant claims and the prior art is that the prior art does not identically disclose the amounts of each component present as is herein claimed. However, there is overlap between the catalyst ingredients and it is well settled that overlapping subject matter constitutes a prima facie case of obviousness. See particularly column 2.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,063,728 to Hinago et al.

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Hinago et al. disclose catalyst compositions that are mixed metal oxides containing molybdenum, antimony, vanadium and at least one of (which includes mixtures) alkaline earth metals and aluminum which read on the herein claimed compositions. The difference between the instant claims and the prior art is that the prior art does not identically disclose the amounts of each component present as is herein claimed. However, there is overlap between the catalyst ingredients and it is well settled that overlapping subject matter constitutes a prima facie case of obviousness. See particularly column 4.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as the amounts of catalytic materials present in the composition which the skilled artisan would be expected to optimize. This would additionally include limitations such as the presence of a support material, or the nature of the calcination treatment used to produce the claimed composition. Moreover, any such differences are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicants should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

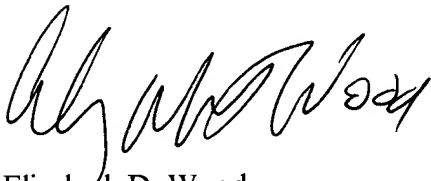
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The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

***Conclusion***

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 should be submitted prior to final rejection so as to be considered timely. It is anticipated that the next office action will be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liz Wood whose telephone number is (703) 308-3802.

A handwritten signature in black ink, appearing to read 'Elizabeth D. Wood', is positioned above the printed name.

Elizabeth D. Wood  
Primary Patent Examiner  
Group Art Unit 1755

June 2, 2000